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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91227978
Party	Defendant The Insurance Source
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Submission	Motion to Consolidate
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Date	08/30/2016
Attachments	2016-08-30 WE MAKE HEALTH INSURANCE EASIER mot consolidate reply FINAL.pdf(226401 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Combined Insurance Company of America  
Opposer,

v.

The Insurance Source,  
Applicant.

Opposition No. 91227978  
Cancellation No. 92064138


**REPLY IN SUPPORT OF MOTION TO CONSOLIDATE**

Opposer/Petitioner Combined Insurance Company of America (“Petitioner”) opposes Applicant/Registrant The Insurance Source’s (“Registrant’s”) Motion to Consolidate on the grounds that Registrant’s marks have unshared design elements and that the burdens of proof differ in the two proceedings. Opposition Docket No. 14, Cancellation Docket No. 6. Petitioner disagrees, and again requests that the Board grant the motion to consolidate.

Petitioner argues that Registrant’s marks are not the same, and thus the likelihood of confusion analysis in the Opposition differs from that in the Cancellation. Registrant acknowledges that its mark in the Cancellation has design elements and words that are not shared by the mark in the Opposition proceeding. Even so, the relevant portion of the marks, the phrase WE MAKE HEALTH INSURANCE EASIER, are the sole portions of the marks that are alleged to be confusingly similar. *See* Table 1, below. Petitioner has plead the same marks in both proceedings, and the complaints in both proceedings are nearly identical. Petitioner’s argument that the marks are too different to consider alongside each other for the purposes of a confusion analysis is unbelievable given that Petitioner believes its own marks to be too similar

to Registrant's marks for confusion purposes—despite even greater differences between the marks. The confusion analysis in both matters will substantially overlap.

**Table 1: Comparison of Marks and Proceedings**

	<b>Cancellation</b>	<b>Opposition</b>
<b>Registrant's Mark</b>		<p>We Make Health Insurance Easier.</p>
<b>Petitioner's Pleaded Marks</b>	<p>Combined Insurance. Let's Make This Easy</p> <p>Let's Make This Easy</p> <p>HAGAMOS ESTO FÁCIL</p>	<p>Combined Insurance. Let's Make This Easy</p> <p>Let's Make This Easy</p> <p>HAGAMOS ESTO FÁCIL</p>
<b>Registrant's Services</b>	<i>Class 36: Online insurance brokerage specializing in health, life, disability, and dental insurance</i>	<i>Class 36: Online insurance brokerage specializing in health, life, disability, and dental insurance</i>
<b>Opposer's Services</b>	<p><i>Class 36: Underwriting all forms of life, accident and health insurance</i></p> <p>(HAGAMOS ESTO FÁCIL only)  <i>Class 36: insurance services, namely, disability insurance underwriting, accident insurance underwriting, supplemental health insurance underwriting, life insurance underwriting, and Medicare supplement insurance coverage</i></p>	<p><i>Class 36: Underwriting all forms of life, accident and health insurance</i></p> <p>(HAGAMOS ESTO FÁCIL only)  <i>Class 36: insurance services, namely, disability insurance underwriting, accident insurance underwriting, supplemental health insurance underwriting, life insurance underwriting, and Medicare supplement insurance coverage</i></p>
<b>Plaintiff</b>	Combined Insurance Company of America	Combined Insurance Company of America
<b>Defendant</b>	The Insurance Source	The Insurance Source
<b>Basis for Claims</b>	Likelihood of Confusion (Section 2(d))	Likelihood of Confusion (Section 2(d))

Even when there are differences between marks, the Board may consolidate the proceedings, and the Board routinely consolidates cases for the sake of economy. For example, in motion involving the opposed marks ADVERTISING FOR HUMANITY, JOURNEY FOR HUMANITY, and JOURNEYS FOR HUMANITY, the Board consolidated three opposition proceedings, stating:

“Since the marks sought to be registered by applicants share some commonality, and inasmuch as opposer has in each instance challenged applicants’ right of registration on priority and the likelihood of confusion, it is believed that these proceedings may be presented on the same record without appreciable inconvenience or confusion, and that such presentation will not be unfairly prejudicial. Moreover, the consolidation would be equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings individually, and would serve the Board’s interest in judicial economy.” *Habitat for Humanity Int’l v. Advertising for Humanity*, Opp. No. 91201673, at 4 (parent) (TTAB Mar. 26, 2013) [not precedential].

Petitioner’s arguments regarding the burden of truth in these matters are equally specious, and not supported by any precedential authority. Petitioner argues that, because Registrant enjoys the presumption of validity in the Cancellation proceeding, the burden of proof it faces in the Cancellation proceeding is much greater than in the Opposition proceeding and that it would be prejudicial to consolidate the issues. Petitioner has not alleged, however, that Registrant’s registered mark is invalid because of non-use, fraud, genericness, or any other ground besides the plead allegations of likelihood of confusion. The issue of confusion is essentially identical, regardless of any presumption of validity, in both cases: Petitioner has the burden of showing that Registrant’s mark is likely to cause confusion with Petitioner’s plead marks. The Petitioner must prove confusion by a preponderance of the evidence in both proceedings. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000). Petitioner must do so according to the *du Pont* factors in both proceedings.

Applicant moved for consolidation of two clearly related matters to save the time and resources of both parties and the Board. Petitioner's opposition to that motion serves only to further waste the time and resources of all involved. Its opposition to the motion is spurious at best. There is absolutely no prejudice in consolidating these cases.

Accordingly, Applicant requests that the Board grant this Motion to Consolidate.

Dated this 30th day of August, 2016.

A handwritten signature in black ink, appearing to read 'Erik M. Pelton', with a stylized, cursive script.

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of Reply in Support of Motion to Consolidate has been served on the following by delivering said copy on August 30, 2016, via First Class Mail, to counsel for Petitioner/Opposer at the following address:

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By: 

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Erik M. Pelton, Esq.